REMARKS

Reconsideration of the above-identified patent application in view of the amendment above and the remarks below is respectfully requested.

Claims 1-2, 4-6, 8-11, 14-16, 20-50, 52-55 and 57 have been canceled in this paper. Claims 13, 17, 18 and 56 have been amended in this paper. No new claims have been added in this paper. Therefore, claims 3, 13, 17-19, 51 and 56 are pending and are under active consideration.

In paragraph 3 of the outstanding Office Action, the Patent Office states that the Information Disclosure Statement filed on July 15, 2003 was not considered because PTO Form FB-A820[1] cannot be located. In response, Applicants note that, as evidenced by the enclosed copy of a postcard stamped by the Patent Office, the form in question was, in fact, received by the Patent Office on July 15, 2003. Applicants are enclosing herewith a copy of the aforementioned form and request that the Patent Office consider the references in question. In view of the fact that the form in question was previously received by the Patent Office, it is not believed that a fee is due at this time.

Also in paragraph 3 of the outstanding Office Action, the Patent Office states that the Information Disclosure Statement filed on September 5, 2003, has been received but that "Japanese references 6-165794, 7-276391 and 8-81503 and the article 'The New Demand for Shape-Memory Resins in Liquid Form' cannot be located in the file, and have not been considered." In response, Applicants note that, as evidenced by the enclosed copy of a postcard stamped by the Patent Office, the references in question were, in fact, received by the Patent Office on July 15, 2003. Applicants

[1] As noted in MPEP § 609, a listing of references need not be provided exclusively using PTO Form 1449, but rather, may alternatively be listed in an equivalent thereto. Applicants respectfully submit that the PTO Form FB-A820 is a suitable equivalent form.

are enclosing herewith copies of the references, as well as a copy of the form listing the references, and request that the Patent Office consider the references in question and note said consideration on the enclosed form. In view of the fact that the references in question were previously received by the Patent Office, it is not believed that a fee is due at this time.

If, for some reason, any of the above-mentioned items become separated from this paper and do not make their way into the file for the subject application, Applicants respectfully request that the Patent Office contact the undersigned by telephone, and the undersigned will gladly provide copies of any missing items to the Patent Office.

Claims 1, 3, 5-6, 13, 17-19, 32, 46, 51, 53 and 56 stand rejected under 35 U.S.C. 112, first paragraph, "as based on a disclosure which is not enabling." In support of the rejection, the Patent Office states the following:

> The claimed rubber material having a transition temperature of 94-99°F is critical or essential to the practice of the invention, but not included in the claims is not enabled by the disclosure. See In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).
>
> In the present specification Applicant's invention appears to be directed to that which will return to its original size or shape upon heating at or near the human body temperature.
>
> Therefore, "the transition temperature in the range of 94 to 99 degrees Fahrenheit" should be recited accordingly.
>
> Furthermore, the independent claims appear to be much broader in scope with respect to the transition temperature than that taught or suggested by the present specification.

Later in the Office Action, the Patent Office states the following:

> Applicant's attention is directed to page 10, lines 11-17 of the present specification, which discloses that "trans-1,4-polybutadiene is a rubbery material that has a transition temperature very close to

> 98.6 degrees Fahrenheit, which would make it a very desirable candidate to be used in a condom." Although Applicant has not elected the trans-1,4-polybutadiene, if the species are rejoined and the trans-1,4-polybutadiene species considered for patentability, then there clearly becomes a 112, first paragraph issue regarding the transition temperature.
>
> Applicant's argument "that the gloves warm up to the transition temperature due to body heat alone, externally applied heat, special lighting, X-irradiation, or other methods of effectively heating an object," found at the bottom of page 8, is not convincing. The other methods disclosed by Applicant means just that, other methods; however, such different methods of warming do not necessarily suggest a transition temperature outside that of the 94-99°F range. Although these methods may be capable of warming to temperatures exceeding 99°F, it is the Examiner's position that the rubbery materials, such as trans-1,4-polybutadiene would clearly recover once the rubber material reaches a temperature close to that of human body temperature, as further disclosed in the present specification.

Applicants respectfully traverse the subject rejection. The present rejection is apparently based on the Patent Office's position that a transition temperature of 94-99°F is essential to the operation of the present invention. Applicants respectfully submit that the Patent Office's position is unsupported by the present specification.

The present specification does not contain a single statement specifying that the transition temperature of the rubbery material **must** be 94-99°F. At best, the present specification states that the transition temperature of the rubbery material **may** have a transition temperature of 94-99°F (see page 3, line 18, of the present specification) or **desirably** has a transition temperature of about human body temperature when the rubbery material is used *as a condom* (see page 10, lines 12-13, of the present specification). Clearly, such language is a far cry from **requiring** that the rubbery material **must** have a transition temperature of 94-99°F. In fact, the present specification specifically

provides for transition temperatures that are higher or lower than 94-99°F (see page 9, line 14-16, of the present specification).

In effect, what the Patent Office is doing, by requiring all of the claims to recite a transition temperature of 94-99°F, is improperly limiting the claims to only one out of many different embodiments disclosed in the specification. The specification clearly provides, on page 10, lines 11-20, that while "[s]ome of these rubbery materials...can be manufactured to shrink at human body temperature (as during sexual intercourse)," "[o]ther rubbery products can be manufactured in relation to other temperatures" and "[a] variety of transition temperature choices allows for uses of condoms and for uses other than condoms."

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Applicants note that claims 3, 17-19, 51 and 56 have not been rejected on the basis of any art. Consequently, in view of the fact that the only rejection of these claims, namely, the above-discussed rejection under 35 U.S.C. 112, first paragraph, should be withdrawn for at least the reasons provided above, Applicants respectfully submit that claims 3, 17-19, 51 and 56 are allowable at this time.

Claim 32 stands rejected (i) under 35 U.S.C. 112, first paragraph, (ii) under 35 U.S.C. 112, second paragraph, and (iii) under 35 U.S.C. 102(e). In view of the cancellation herein of claim 32, the aforementioned rejections are moot and should be withdrawn.

Claims 1, 5, 6, 13, 46 and 53 stand rejected under 35 U.S.C. 102(b) "as being anticipated by Kuan et al. (US 4,891,409)."

Insofar as the aforementioned rejection pertains to claims 1, 5, 6, 46 and 53, said rejection is moot in view of Applicants' cancellation herein of claims 1, 5, 6, 46 and 53. Insofar as the subject

rejection pertains to claim 13, Applicants have amended claim 13 so that it no longer depends from rejected claim 5, but rather, depends from claim 3, which is allowable over the art of record.

Therefore, for at least the above reasons, the subject rejection should be withdrawn.

In conclusion, it is respectfully submitted that the present application is in condition for allowance. Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Kriegsman & Kriegsman

By: _____

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Dated: September 2, 2004

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 2, 2004.

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Edward M. Kriegsman
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Dated: September 2, 2004